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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE P. COPELAND, MICHAEL H. CONNER
and GREGORY A. FLURRY

Application No. 09/740,531

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on January 6, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the file indicates that the appellant filed the Appeal Brief of March 21, 2005 using the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the Appeal Brief filed on March 21, 2005 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37 (c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through

(c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(I) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or

more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

Upon an in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief of March 21, 2005:

- 1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37 (c) (1) (v);

2) "Grounds of rejection to be reviewed on appeal", as set forth in 37 CFR § 41.37(c)(1)(vi).

3) "Evidence Appendix", as set forth in 37 CFR § 41.37(c)(1)(ix); and

4) "Related Proceedings Appendix", as set forth in 37 CFR § 41.37(c)(1)(x).

A substitute brief that is in compliance with § 41.37(c) is required. For more information See United States Patent and Trademark website www.uspto.gov, in particular the web page entitled More Information on the Rules of Practice Before the BPAI, Final rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

The Examiner's Answer mailed June 30, 2005 does not comply with the headings set forth in the new rules under 37 CFR § 41.37(c). See MPEP 1207.02. Correction is required.

Also, upon review of the Examiner's Answer mailed on June 30, 2005, there is no indication that an appeal conference has been conducted. According to the Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., August 2001), when an appeal conference has been held, the appeal conference conferees, which includes a supervisory patent examiner, and another examiner as a conferee

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must identify themselves as the conferees, along with placing their initials next to their name. Only the signature and name of one conferee appears.

Further, on January 21, 2005, appellants filed a paper entitled "NOTICE OF APPEAL", which authorized payment of any fees which may be required to Deposit Account No. 50-3268/5468-05700. The fees for the Notice of Appeal and Appeal Brief has not been charged.

Accordingly it is

ORDERED that the application is electronically returned to the Examiner to:

- 1) hold the Appeal Brief of March 21, 2005 defective;
- 2) for applicant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for the examiner to consider the substitute Appeal Brief, vacate the Examiner's Answer mailed June 30, 2005, and issue a revised Examiner's Answer in accordance with the new rules effective September 13, 2004;
- 4) to take corrective action regarding the appeal conference;
- 5) for charging the Notice of Appeal and Appeal Brief fees to Deposit Account No. 50-3268/5468-05700; and

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6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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By:



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